

REMARKS/ARGUMENTS

Claims 1-5, 7, 8, 10-11, 13 and 15-24 are currently a part of this application.

The undersigned wishes to thank the Examiner for the courtesy extended during the interview at the USPTO on October 13, 2006. The Examiner's time and consideration is greatly appreciated.

A. Claim Rejection Under 35 U.S.C. § 102(e)

Claims 1-5, 7, 10, 11, 13 and 22-24 have been rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Publication No. US 2002/0110679 to Miller et al. (hereafter “*Miller*”). The Examiner asserts that *Miller* discloses a “storm proof asphalt-based roofing material” which “includes a substrate coated with an asphalt coating, a protective coating, a layer of granules, and a web bonded to the lower region of the asphalt coating.”

In the current Office Action, the Examiner has maintained her previous rejections. Again, the Applicants respectfully disagree and request reconsideration. More specifically, the Examiner is of the position that claim 1, as currently written, does not preclude the use of additional layers, i.e., a protective layer.

As communicated in response to previous Office Actions in this application, *Miller* does not teach an impact resistant roofing shingle according to the present invention having the following elements: (a) asphalt coated non-woven glass fiber substrate, (b) an exposed (or upper) surface of said substrate layered with granules, and (c) an unexposed (or lower) surface coated with an adhesive and laminated to an organic film.

Rather, *Miller* requires an additional, protective coating (adhesive) on the upper surface of the asphalt coating and upon which granules are applied. (emphasis added). In the invention

recited in the claims of the present application, the adhesive is coated on the asphalt on the unexposed or lower surface of the substrate which is laminated to an organic film. (emphasis added). The adhesive and its positioning on the lower surface of the substrate is not merely a design choice, but serves the important function of transmitting shock applied on the shingle and reducing cracking of the shingle by flowing into the cracks caused by impacts.

According to paragraph [0047] of *Miller*, a protective coating (i.e., a polymeric material that functions as an adhesive, as recited in paragraph [0052]) is adhered to the upper surface of the asphalt coating and the granules are adhered to the protective coating. Claim 1 as amended recites a shingle “comprising an asphalt coating on a non-woven glass fiber substrate wherein an exposed surface of said substrate is provided having granules directly layered on said asphalt coating...” The shingle of the present invention does not include an additional or protective layer of any type on the upper or exposed surface of the substrate as required by *Miller*. The exposed surface of the substrate of the shingle in the present invention comprises only an asphalt layer and the granules are directly layered upon the asphalt. As such, claim 1 as amended precludes a protective (or any other) coating on the asphalt coating on the upper surface of the substrate.

In order to facilitate the Examiner’s understanding of the differences between claim 1 and *Miller*, Applicants herein provide a side-by-side comparison:

Claim 1 (as amended)

Impact resistant roofing shingle

an asphalt coating on a non-woven glass fiber substrate

an exposed surface of said substrate is provided having granules directly layered on said asphalt coating

unexposed surface is coated with an adhesive

and laminated to an organic film.

Miller

Roofing material having improved durability and impact resistance [0001]

substrate coated with an asphalt coating [0011]; Preferably substrate is a nonwoven web of glass fibers [0036]

protective coating adhered to upper surface of asphalt coating [0011]; a surface layer of granules adhered to the protective coating [0011]; Preferably, the web is bonded to the substrate prior to the asphalt coating step, either intermittently or continuously along their lengths. Any suitable bonding apparatus 146 can be used to bond the web to the substrate. [0056]; The web can be bonded to the asphalt coating at any location in the lower region. [0059]; The strong bond is achieved by fusing the web and the asphalt coating. Specifically, a portion of the web and of the asphalt coating are intermingled by melting, thereby fusing the web and the asphalt coating. [0060]

a web bound bonded to the lower region of the asphalt coating [0011]

the protective coating is applied as a film [0041]

Accordingly, since *Miller* requires a protective coating between the asphalt and the granules on the upper surface, claim 1 as amended is not anticipated. Withdrawal and reconsideration of the rejection to claim 1 under 35 USC § 102(e) is respectfully requested. Since claims 2-5, 7, 8, 10-11, 13 and 22 depend directly or indirectly from amended claim 1,

these claims incorporate all the limitations of amended claim 1 and are likewise not anticipated for the same reasons as asserted with regard to amended claim 1.

Additionally, independent claim 23 as amended is not anticipated for the same reasons as recited with respect to independent claim 1. Claim 24 depends directly from claim 24 and incorporates all the limitations of claim 24 therein. As such, claim 24 is not anticipated for the same reasons asserted with regard to claim 23.

B. Claim Rejections Under 35 U.S.C. § 103(a)

1. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Miller* (discussed above). The Examiner stated that *Miller* discloses the claimed invention except for the teaching that the polyester film is specifically a polyethylene terephthalate. According to the Examiner, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used polyethylene terephthalate as the polyester film in the *Miller* roofing material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Applicants request reconsideration of this rejection. Claim 8 depends indirectly from claim 1 and incorporates all the limitations of claim 1 therein. As asserted above with regard to the rejection under 35 U.S.C. § 102, *Miller* does not recite each and every element as recited in amended claim 1, nor does *Miller* suggest an impact resistant roofing shingle having an asphalt coated non-woven glass fiber substrate, an exposed (or upper) surface of said substrate layered with granules, and an unexposed (or lower) surface coated with an adhesive and laminated to an polyethylene terephthalate organic film. As such, there is no teaching or suggestion in *Miller*

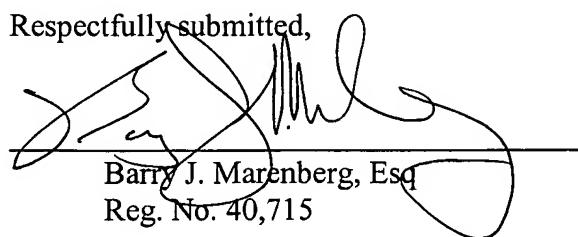
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directed to the impact resistant roofing shingle as recited in dependent claim 8. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious).

In view of the aforementioned remarks and amendments, the Applicants believe that each of the pending claims is in condition for allowance. If, upon receipt and review of this amendment, the Examiner believes that the present application is not in condition for allowance and that changes can be suggested which would place the claims in allowable form, the Examiner is respectfully requested to contact Applicants' undersigned counsel at the number provided below.

Please charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 03-1250 (Ref. No. FDN-2824).

Date: 11/13/06

Respectfully submitted,

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